

ATTORNEY DOCKET NO.: PNM01 010 CONT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Continuation Patent Application of Chris Quinlan and Edward A. Devlin

Confirmation No.: 8510

Serial No.: 10/661,886

Art Unit: 3688

Filed: September 15, 2003

Examiner: Daniel Lastra

Title: METHOD AND SYSTEM FOR REDEEMING PRODUCT
MARKETING REBATES

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

In response to the Examiner's Answer dated October 6, 2010, Appellant hereby submits this Reply Brief.

Respectfully submitted,

/pdm/

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I. The Examiner's Answer is Unresponsive to Appellant's Brief

The Examiner's Answer is wholly unresponsive to the substantive issues raised in Appellant's Brief. Pages 3-15 of the Examiner's Answer is essentially a verbatim copy of the examiner's final office action and remains deficient for the reasons discussed in Appellant's Brief. With respect to the Examiner's "Response to Argument" on pages 16-25, the examiner failed to address the points raised in Appellant's Brief, and instead tries to support the anticipation rejection by modifying the express disclosure of Jacoves and ignoring those portions of Jacoves that do not support the examiner's position.

A. Transaction Identifier/ Transaction Code

In Appellant's Brief on pages 17 and 18, the appellant identified that the examiner's rejection is deficient with respect to Claim 102 because the transaction identifier identified by the examiner, the UID, is not used "to access the information provided by the supplier and the marketing entity to ascertain the applicability of promotions to the goods in the identified purchase transaction" as recited in the claim. Specifically, the appellant pointed out that paragraph 71, which is cited by the examiner as disclosing this limitation, is silent with respect to this limitation. In fact, paragraph 71 expressly states that "the redemption file contains only the UID and the date and time stamp." In his response at page 21 and 22 in the Examiner's Answer, the examiner asserts "the redemption file is the potential file shown in FIG. 16" and provides his analysis of how the claim language reads on his interpretation of Jacoves. However, FIG.

16 is labeled “Potential File” and includes the following information: UPC, UID, TOTAL DISCOUNT/UPC REDEEMED. In contrast, paragraph 71 states that the “redemption file” contains only the UID and the date and time stamp.” Thus the redemption file and the potential file are two completely different files and thus the whole basis for the examiner’s rejection of this claim limitation is improper. The redemption file clearly does not include “information provided by the supplier and the marketing entity to ascertain the applicability of promotions to the goods in the identified purchase transaction” and thus this rejection should be withdrawn.

Moreover, Claim 102 requires that the unique identifier provided by the purchaser is used to access information provided by the supplier (*i.e.*, promotion information) and the marketing entity (products purchased) to determine the applicability of promotions, and to validate the applicable promotions. Jacoves does not disclose and the examiner does not assert that the potential file is used to determine the applicability of promotions or to validate the applicable promotions. Instead, the examiner asserts that the potential file is updated to reflect “redeemed”. The fact that an instant discount has been redeemed is separate and distinct from the claimed steps of determining the applicability of a promotion. Thus, even if the “redemption file” is the “potential file” (which it clearly is not!), Jacoves still does not disclose each of the recited claim limitations.

B. Jacoves Does Not Disclose The Use of Product Information to Validate A Rebate

Notwithstanding that Jacoves does not disclose the use of the UID to validate the instant discount as discussed above, Jacoves does not disclose the use of product

information to validate the instant rebate as discussed at page 18 of the Appellant's Brief. In response, the examiner asserts at page 23 of his Answer that redemption slip UID is matched with the UID in the potential file in order to mark the potential file as redeemed before the discount is provided to the customer because:

it is necessary that the fuel retailer validates the rebate discounts given using the potential file by flagging said items that provides rebates as redeemed because if said fuel retailer does not do said validation, he would give rebate discounts to customers without being able to be reimbursed by the manufacturers for said given discounts.

The examiner's rationale evidences a fundamental lack of understanding of the teaching of Jacoves. First, it is only necessary that the redeemed field in the potential file be updated **before** the potential file is sent to the manufacturer for reimbursement of the discounts to the fuel retailer. Second, the potential file is created at the time of the initial transaction and is created after it is determined which products purchased provide for an instant discount. As such, it would be unnecessary and redundant to review the potential file again at the time an instant discount is redeemed. Instead, as explained in paragraph 45 of Jacoves, the instant discount is redeemed using the four digit code of a token without the necessity of checking the potential file. Further at paragraph 71, Jacoves clearly shows that that the instant discount is provided upon presentation of the redemption slip without reference to the potential file.

C. The Examiner Misunderstands the Appellant's Arguments

The examiner asserts in page 20-21 that the "Appellant argues that the examiner should be reversed because he is switching positions without explanation." This is not

the appellant's position. Rather, the appellant asserts that the examiner should be reversed because Jacoves does not disclose the claimed limitations and the examiner is improperly modifying the teachings of Jacoves to support his unfounded rejection. The fact that the examiner has been unable to provide an explanation for why he reversed his position is just further evidence that Jacoves does not support what the examiner is now asserting is the basis for his rejections. The examiner also asserts that "according to the applicant, the Examiner should be reversed because he cannot use different embodiments of the same prior art to make a rejection." This is not the appellant's position. Rather, the appellant asserts that there is no "embodiment" in which the redemption file is the potential file as asserted by the examiner. The examiner's rejection is not based on a disclosed embodiment, instead it is based on an improper modification to the teachings of Jacoves.

II. Conclusion

Thus, as shown in Appellant's Brief and confirmed in the Examiner's Answer, the rejection of claims 102-126 under 35 U.S.C. § 102 as being unpatentable over Jacoves is based on a fundamental misunderstanding of the teachings of Jacoves. When Jacoves is considered as a whole, including the express teachings that a "four-digit code" or a "token" is used to claim the instant discount, it is clear that Jacoves does not disclose each of the claimed limitations of the present application as asserted by the examiner. Appellant respectfully requests that the rejections of the examiner be reversed.